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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,028	03/11/2004	Ernest Aranyi	2891	6009
7590	05/16/2006		EXAMINER	
Lisa J. Moyles U.S. Surgical, a division of TYCO Healthcare Group, LP 150 Glover Avenue Norwalk, CT 06856			SONNETT, KATHLEEN C	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 05/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/798,028	ARANYI ET AL.	
	Examiner Kathleen Sonnett	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 and 19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 3/11/2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/28/2005</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 and 19, drawn to an apparatus for applying surgical clips, classified in class 606, subclass 205.
- II. Claims 12-16, drawn to a method of using the clip applying apparatus, classified in class 128, subclass 898.
- III. Claims 17 and 18, drawn to surgical clips, classified in class 606, subclass 151.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product can be used in a materially different process such as for grasping and picking up a light article not associated with the human body.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

Art Unit: 3731

process of using that product. See MPEP § 806.05(h). In the instant case the product can be used in a materially different process such as the clip can be used in upholstery repair.

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination III has separate utility such as the clip can be used in a different clip applying apparatus that does not have the same structure of invention I. For example, the clip can be clamped on by hand if it is grasped between two fingers and squeezed shut. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper. During a telephone conversation with Chris Trainor on 5/4/2006 a provisional election was made with traverse to prosecute the invention of the clip applying apparatus (invention I), claims 1-11 and 19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Sherman (U.S. 5,921,996). Sherman discloses a clip applying apparatus including a handle assembly (26), a body portion defining a longitudinal axis (35), and a plurality of jaw mechanisms including first and second jaws having predefined radius of curvature, wherein the radius of curvature of the first and second jaws of each of the plurality of jaw mechanisms is different from the radius of curvature of each of the first and second jaws of each of the other of the plurality of jaw mechanisms (see last 3 lines of abstract, col. lines 36-39, col. 4 lines 14-24, and Fig. 2a-2f).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castro et al. (U.S. 5,797,959). Castro et al. discloses an apparatus with a handle

Art Unit: 3731

assembly (16), a body portion (22) defining a longitudinal axis and extending distally from the handle assembly and a jaw mechanism including first and second jaws (36, 38) configured to receive a clip there between. The first jaw is movable in relation to the second jaw between open and closed positions and each jaw is curved upwardly toward its distal end along the longitudinal axis of the body. Although shown pointing down in Fig. 1, the jaw assembly can be rotated by turning knob (40) so that the jaws point upwardly. Castro et al. does not disclose a radius of curvature between about 0.5 inches and 0.9 inches. However, the criticality of such dimension is not disclosed in the specification of the instant application and therefore it is not a patentably distinct feature from the invention disclosed by Castro et al. Furthermore, the specification does not disclose any particular advantage gained or problem solved by using the particular dimensions. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention was made to have modified Castro et al. such that the radius of curvature falls between 0.5 and 0.9 inches or is 0.7 inches because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Castro et al.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pistl (U.S. 5,626,586) in view of Klieman et al. (U.S. 4,325,376). Pistl discloses a clip applying apparatus including a handle assembly (11), a body portion (7), and a jaw mechanism including first and second jaws (6) configured to receive a clip there between, the first jaw being movable in relation to the second jaw between open and closed positions.

Regarding claim 3, the handle includes an actuation member (12) and the apparatus further includes a closure member (5) movably positioned within the body portion, the closure member being operably connected to the actuation member through an actuation stroke (col. 2 lines 33-36 and col. 3 lines 29-38).

Regarding claim 4, the jaw mechanism includes a body and first and second spaced shank members extending distally from the body, the first and second jaws extending from a distal end of the first and second shank members, respectively. First and second spaced shank members can be seen in Fig. 7. They are being considered the portion of the jaw mechanism proximal to the portion of each of the jaw members that has the flattened engaging surface as seen in Fig. 7.

Regarding claim 5, the first and second shank members include a cam surface, the closure member being movable into engagement with the cam surface of the first and second shank members to move the first and second jaws from the open to closed position (see col. 4 lines 17-23).

Regarding claim 6, the jaw mechanism is one piece as seen in Fig. 7.

Regarding claim 7, the apparatus has a rotatable knob (13) that rotates the body portion and jaw mechanism in relation to the handle assembly (col. 2 lines 35-38).

Regarding claim 8, the actuation member includes a pivotable trigger (Fig. 1).

Pistl et al. discloses what appear to be curved jaw members in Fig. 2, but Pistl et al. does not expressly disclosed curved jaws in the text.

However, Klieman et al. discloses that it is old and well known to provide a jaw mechanism that has upwardly curved jaw members. Klieman et al. further discloses that

the curved jaw members provide increased visibility during usage (col. 6 lines 59-63). Klieman et al. does not disclose a radius of curvature between about 0.5 inches and 0.9 inches. However, the criticality of such dimension is not disclosed in the specification of the instant application and therefore, it is not a patentably distinct feature from the invention disclosed by Klieman et al. However, the criticality of such dimension is not disclosed in the specification of the instant application and therefore it is not a patentably distinct feature from the invention disclosed by Klieman et al. Furthermore, the specification does not disclose any particular advantage gained or problem solved by using the particular dimensions. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention was made to have modified Klieman et al. such that the radius of curvature falls between 0.5 and 0.9 inches or is 0.7 inches because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Klieman et al. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Pistl et al. to include curved jaw members as made obvious by Klieman et al. in order to increase visibility for the surgeon during usage.

Regarding claims 9-11, Pistl discloses the invention substantially as stated above including clips which are supported between the first and second jaws, but fails to disclose that the clips have a pair of legs and a backspan or that the clips have the same radius of curvature as the jaw members.

However, Klieman et al. discloses that it is old and well known in the art to use clips that have a pair of legs and a backspan (Fig. 12, "37"). The clips disclosed by

Art Unit: 3731

Klieman et al. are held between the jaws and are therefore sized to match the dimensions of the jaws. Klieman et al. further discloses that the clips are deformable (col. 3 line 66-col. 4 line 5). Using the deformable clips made obvious by Klieman et al. in the modified device of Pistl that has curved jaws would result in clips that are deformed into a shape with a radius of curvature matching the radius of curvature of the jaws. Deformable clips can be easily actuated by applying pressure to them and essentially clamping the arms together through the use of an open and closing jaw mechanism. Therefore, it would have been obvious to one of ordinary skill in the art to include deformable clips that have dimensions similar to the jaws as made obvious by Klieman et al. in the device disclosed by Pistl in order to gain the advantage of having an easy method of actuating the clips.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 6,520,972. Patent ('972) shows a surgical clip applier with curved shoulders on its jaws.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Sonnett whose telephone number is 571-272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone

Art Unit: 3731

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCS
5/8/2006



GLENN K. DAWSON
PRIMARY EXAMINER